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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,424	12/12/2003	Roger Francis Bernards	14993US01	2278

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EXAMINER

KOPEC, MARK T

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,424

Applicant(s)

BERNARDS ET AL.

Examiner

Mark Kopec

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 10-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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This action is responsive to applicant's amendment/remarks filed 11/03/05. Claims 1-37 are pending with claims 10-37 withdrawn from consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The previous prior art rejection over Cheng et al is withdrawn in view of applicant's amendment and remarks.

Note the following new grounds of rejection:

Claims 1-7 and 9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Sano et al (6,676,738) or Arita et al (6,730,149).

Sano et al discloses a black ink composition containing a carbon black and a pigment. Also disclosed is an ink set containing at least one kind of such a black ink composition as at least one of a black ink composition and a light black ink composition (Abstract). The aqueous black ink composition for ink jet recording method of the invention preferably comprises the carbon black in an amount of from 1 to 10 parts by weight, more preferably from 1.5 to 5 parts by weight based on the total weight of the ink composition (Col 4, lines 57-61). The black ink composition of the invention preferably further comprises a preservative, a metal ion capturing agent and/or rust

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preventive. As the rust preventive there is preferably used dicyclohexylammonium nitrate and/or benzotriazole (Col 7, lines 28-43). Examples 1-4 contain carbon black, water, and 0.1-0.3 Proxel GXL (thiazole). The reference specifically or inherently meets each of the claimed limitations.

Arita discloses An ink composition including a colorant; and a solvent, wherein a zeta potential 2 between the colorant and a material selected from the group consisting of silicon, glass, silicon oxide, titanium oxide, chromium oxide, titanium nitride, silicon nitride, zirconium and polyimide is from 0 to - 50 mV at a pH of from 6.5 to 11.5. A corrosion inhibitor is preferably added to the ink composition to adjust the zeta potential 2 (Abstract). Example 9 (Col 41) discloses carbon black (5 wt%), water, and 0.5 wt% corrosion inhibitor. The reference specifically or inherently meets each of the claimed limitations.

The references are anticipatory.

In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a particular corrosion compound or minor variation in additive percentage, such modifications are well within the purview of the skilled artisan.

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Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Thakkar et al (6,203,605).

Thakkar discloses an ink jet composition comprising 22 wt% modified carbon, 0.1 wt% corrosion inhibitor, and water (Example 2). The reference specifically or inherently meets each of the claimed limitations.

The reference is anticipatory.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakkar et al (6,203,605).

Thakkar is relied upon as set forth above. The reference differs from the instant claims in failing to specify the claimed Markush group of corrosion inhibitor agents.

It is the examiner's position that the claimed corrosion inhibitor compounds are notoriously well known in the art and their selection would have been obvious to the skilled artisan in view of the general teachings of Thakkar et al.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Sano et al (6,676,738) or Arita et al (6,730,149).

Both both Sano et al (6,676,738) and Arita et al (6,730,149) are relied upon as set forth above. The references differ from the instant claims in failing to specify the claimed Markush group of corrosion inhibitor agents.

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It is the examiner's position that the claimed corrosion inhibitor compounds are notoriously well known in the art and their selection would have been obvious to the skilled artisan in view of the general teachings of either Sano et al (6,676,738) and Arita et al (6,730,149).

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Kopec
Primary Examiner
Art Unit 1751

MK
December 2, 2005